

REMARKS

Upon entry of the present amendment claims 1-24 are pending in the application. Claims 19-24 were canceled without prejudice. Applicants respectfully request reconsideration of the claims in view of the following remarks:

1. **Election/Restrictions**

Applicants' reply of 2/16/07 elected to prosecute the invention of Group I, claims 1-18, drawn to a method of making a treatment element classified in class 502, subclass 439.

In the instant Office Action, claim 9 appears to have been improperly withdrawn from consideration without explanation. Applicants respectfully request clarification.

2. **Nonrejection of claim 8.**

Although the Summary of the Office Action of May 2, 2007 indicates that claims 1-8 and 10-18 stand rejected, no basis of rejection has been set forth in regard to claim 8 in the body of the Office Action. Accordingly, Applicants are confused as to the status of claim 8.

Clarification of the status of claim 8 is respectfully requested as well as the rationale and basis of any substantive prior art rejection of claim 8.

3. **Rejection of claims 1-7 and 9-18 under 35 U.S.C. §103(a) as unpatentable over Suzuki et al., U.S. 6,217,831 hereafter " '831'".**

Claims 1-7 and 9-18 stand rejected as obvious over Suzuki. The PTO admits that "Suzuki fails to disclose applying both and then calcining the substrate." (*Office Action of 5/2/07, page 2.*) However, the PTO then goes on to say that "[i]t would have be obvious to ...apply both the first and second catalysts and then calcine together because Suzuki discloses arranging the zones together without space in between (Fig. 1 and column

6, lines 11-18), which would suggest to an ordinary skilled artisan either a single substrate that may be calcined together or separately and subsequently arranged." (*Office Action of 5/2/07, pages 2-3.*)

To establish a prima facie case of obviousness, three basic criteria must be met: (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) There must be a reasonable expectation of success; and (3) the prior art reference (or combined references) must teach or suggest all limitations of the claim(s); MPEP 2143.

Applicants appreciate the detailed basis of rejection but must respectfully disagree. In particular, the PTO's single prior art reference fails to provide a prima facie case of obviousness for several reasons. First, the single reference fails to teach or suggest all limitations of the claims, specifically independent claim 1. Second, there is no motivation in the single prior art reference to make the modifications necessary to result in the invention of Applicants' independent claim 1.

Applicants' independent claim 1 is set forth below for the purposes of discussion:

A method of making a treatment element for an exhaust emission control device, comprising:

applying a first catalyst composition along a first portion of a major axis of **a single substrate**;

applying a second catalyst composition along a second portion of the major axis **of the single substrate** to form a first catalyst zone and a second catalyst zone; and

calcining the substrate;

wherein the first catalyst zone and the second catalyst zone are different.

As noted above, the PTO has admitted that Suzuki fails to disclose the above bolded elements of claim 1. However, the PTO appears to be suggesting that these elements are nonetheless somehow "taught or suggested" as mandated by MPEP 2143.

However, the express teachings of Suzuki indicate that this proposition is unsupportable.

Moreover, Applicants' method of independent claim 1 contains another equally important limitation that has been ignored by the PTO, i.e., the application of the first and second portions must be made to particular locations of "a single substrate". This required element of Applicants' claim 1 has been highlighted above using italics, bolding and underling. Thus, Applicants' claimed method of making a treatment element requires that the first and second catalysts be respectively applied to particularly located first and second portions of **a single substrate**.

In contrast, Suzuki clearly teaches that each of his three required catalysts are made separately with different substrates and catalyst metals, i.e., (i.e., substrates 10/11, 20/21, and 30/31) and that each of the three different catalysts (i.e., First, Second, and Third Catalysts) must be made separately.

For example, Suzuki at col.5, ll. 22 through col. 6, ll. 1-11 teaches that honeycomb supports 10 and 20 are coated with very different catalyst carrier layers, i.e., respectively silicon dioxide for layer 11 and alumina oxide for layer 21. As a result, the catalyst substrates 10/11 and 20/21 of Suzuki cannot be made using "a single substrate" as is required by the method of Applicants' claim 1.

This position is further supported by the fact that each of Suzuki's three different catalysts are made by immersing the appropriate support/layer (i.e., respectively 10/11; 20/21; and 30/31) in a unique solution for each of the three different catalysts (i.e., respectively: aqueous bivalent platinum ammine hydroxide solution for the First Catalyst, aqueous barium acetate solution for the Second Catalyst, and aqueous platinum dinitrodiammine solution for the Third Catalyst).

As a result, it is not possible, let alone obvious, for one of skill in the art to obtain Applicants' claimed method from the teachings of Suzuki. Indeed, a review of all of the embodiments disclosed by Suzuki as well as the first comparative example indicates that Suzuki teaches that all of the metals on one single support fails to provide desirable results, i.e., that three different substrates are preferable to a single substrate.

Nor does Suzuki's Fifth Embodiment provide any support for the PTO's position. This embodiment, set forth in col. 9, ll. 9-45, expressly requires two different and separate calcination steps for the various types of applied catalyst metals.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 123 U.S.P.Q. 349 (CCPA 1959); MPEP 2143.01. It will be appreciated that Applicants' claimed method contravenes the basic principles of Suzuki. Put another way, it can be stated that Suzuki's comparative examples and working examples expressly teach away from Applicants' claimed method that requires the use of a single substrate and only one calcination step.

Finally, other than to state that it is obvious to try, the PTO has failed to indicate where Suzuki provides any motivation to do what Applicants have done. Clarification is respectfully requested from the PTO on this point.

Since claims 2-7 and 11-18 either depend from claim 1 or are narrower than claim 1, Applicants respectfully submit that these claims are allowable for at least the same reasons as claim 1.

Reconsideration and removal of the rejections as to all of the pending claims is respectfully requested.

CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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